

REMARKS

Claims 1-2, 4-11, and 13-21 are now pending in the application. Claims 1-2, 4-11, 13-17 stand rejected. Claim 12 has been previously cancelled. Claims 18-21 were previously withdrawn from consideration. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 102

Claims 1, 4, 6-7, 10, 13 and 16 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Nakagawa et al. (U.S. Pat. App. No. 2002/0197869; hereinafter "Nakagawa"). This rejection is respectfully traversed.

Initially, Applicant notes that Nakagawa appears to disclose a water-based resist stripping liquid management system that includes a bath 1 for providing a stripping solvent via a pipeline 10 to a sprayer 7. The sprayer 7 sprays the solvent on substrates 6 that pass beneath the sprayer 7 on a roller conveyer 5. In contrast to Nakagawa, independent Claim 1 recites:

removing an amount of resin from the object by **submersing** the object in the liquid in a manner such that the amount of resin becomes dissolved in the liquid and thereby increases the ratio of the dissolved resin to the solvent of the liquid, the increase of the ratio altering an electrical characteristic of the liquid...(emphasis added).

Independent Claim 10 recites:

removing an amount of resin from the object viaby **submersing** the object in the liquid such that the amount of resin becomes dissolved in the liquid and thereby alters the electrical characteristic of the liquid...(emphasis added).

Independent Claim 17 recites:

removing an amount of material by **submersing** the object in the liquid such that the amount of material becomes additional solute in the liquid and thereby increases the ratio of the solute to the solvent of the liquid, the increase of the ratio altering an electrical characteristic of the liquid the liquid comprising Tripropylene Glycol Methyl Ether...(emphasis added).

In view of the above discussion, Applicant respectfully asserts that Nakagawa does not teach, suggest or disclose each and every element of Claims 1, 10 and 17. In this regard, Nakagawa does not teach, suggest or disclose removing an amount of resin from an object by submersing the object in the liquid. Rather, Nakagawa only teaches **spraying** a substrate with a stripping liquid from a sprayer with the liquid provided from a bath, and does not teach, suggest or disclose whatsoever **submersing the object in the liquid**. Nakagawa merely discloses that the substrates are sprayed with a liquid to remove the resist and metal oxides from the top layer of the substrate, which is substantially different than submersing an object in the liquid to remove a resin.

The Office states that “the stripping liquid sprayed onto the surface of the substrate treated does not replenish the bath (the bath under the conveyor) all at the same time” and that “at a given period of time the resist stripping fluid is present above the surface of the substrate i.e., the substrate (object) is submersed in the resist stripping fluid” on the conveyor surface. Applicant respectfully disagrees and notes that Nakagawa does not teach, suggest or disclose whatsoever the submersing of an object in a liquid, and thus, Nakagawa cannot anticipate Claims 1, 10 and 17.

It is well settled that a *prima facie* case of anticipation requires “the presence in a single prior art reference disclosure of *each and every element* of the claimed invention,

arranged as in the claim.” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983) (emphasis added). Additionally, the cited prior art reference must be enabling to place the disclosed subject matter in the hands of the public. See, *Akzo N.V. v. U.S. Int’l Trade Comm’n*, 808 F.2d 1471, 1 USPQ 2d 1241, 1245 (Fed. Cir. 1986) (citing *In re Brown*, 329 F. 2d 1006, 1001, 141 USPQ 245, 249 (C.C.P.A. 1964). Further, the anticipating reference “must describe the patented subject matter with sufficient clarity and detail to establish that the subject matter existed” and that one of ordinary skill recognized its existence. *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 48 USPQ2d 1321, 1328 (Fed. Cir. 1998) (citing *In re Spada*, 911 F.2d 705, 708, 15 USPQ 2d 1655, 1657 (Fed. Cir. 1990); *Diversitech Corp. v. Century Steps, Inc.*, 850 F.2d 675, 678, 7 USPQ 2d 1315, 1317 (Fed. Cir. 1988). The Federal Circuit has also stated that “there must be **no difference** between the claimed invention and the reference disclosure” from the perspective of one with ordinary skill in the art. *Scripps Clinic & Research Found. v. Genentech Inc.*, 927 F.2d 1565, 18 USPQ 2d 1001, 1010 (Fed. Cir. 1991) (emphasis added).

Applicant notes that anticipation, however, may reside even if the prior art reference relied on does not expressly disclose a minor aspect of the claimed invention. Under the principles of inherency, if a structure in the prior art necessarily functions in accordance with the limitations of a process or method claim of an application, the claim is anticipated. *In re King*, 801 F.2d 1324, 231 USPQ 136, 138 (Fed. Cir. 1986). The Federal Circuit has stated:

To serve as an anticipation when the reference is silent about the asserted inherent characteristic, such gap in the reference may be filled with recourse to **extrinsic evidence**. Such evidence must make clear that the missing descriptive matter is

necessarily present in the thing described in the reference and **that it would be so recognized by persons of ordinary skill.** *Continental Can Co. USA v. Monsanto Co.*, 948 F.2d 1264, 20 USPQ 2d 1746, 1749 (Fed. Cir. 1991).

In this regard, the CCPA has added that “[i]nherency, however, **may not be established by probabilities or possibilities.** The mere fact that a certain thing *may* result from a given set of circumstances **is not sufficient.**” *In re Oelrich*, 666 F.2d 578, 581, 212 USPQ 323, 326 (C.C.P.A. 1981) (quoting *Hansgirk v. Kemmer*, 102 F.2d 212, 214, 40 USPQ 665, 667 (C.C.P.A. 1939) (emphasis added)).

Applicant submits that the Nakagawa reference is silent about the asserted inherent characteristic of the resist stripping fluid being present above the surface of the substrate at some point in time, and, moreover, that the Office has not presented any **extrinsic evidence** that would make clear that the missing description matter is necessarily present in the Nakagawa reference, and that it would be so recognized by persons of ordinary skill in the art. Rather, Applicant notes that one of ordinary skill in the art would interpret the term “submersing” to represent “to put or **sink below the surface of water or any other enveloping medium.**” *Random House Unabridged Dictionary* (Random House, Inc. 2006). Applicant notes that it is impossible to **sink** the substrates 6 below the surface of the stripping fluid on the conveyor surface. Further, as illustrated in Fig. 1 of Nakagawa, the stripping fluid is sprayed onto the top surface of the substrate 6, and thus, the rear surface of the substrate 6 (i.e. the surface touching the conveyor) is not taught to be submersed in or enveloped by the stripping fluid.

With regard to the Office’s statement that the spraying of the liquid does not replenish the bath under the conveyor, Applicant notes that Nakagawa explains this effect is due to the “tendency for the water-based resist stripping fluid to stick to the substrates 6 and thus be taken outside of the system, resulting in the amount of the

liquid in the resist stripping treatment bath 1 dropping" (see at least p. 5, paragraph [0061]). Nakagawa does not teach, suggest or disclose that resist stripping fluid is present above the surface of the substrate as suggested by the Office.

Accordingly, for at least these reasons, Applicant respectfully asserts that Nakagawa does not teach each and every element of Claims 1, 10 and 17, and as such, Applicant respectfully requests the Office to reconsider and withdraw the rejection of Claims 1, 10 and 17 under 35 U.S.C. § 102(b).

With regard to Claims 4, 6, 7, 13 and 16, Applicant notes these claims depend directly or indirectly from either independent Claims 1 or 10, and thus, should be in condition for allowance for the reasons set forth for Claims 1 and 10 above. Accordingly, Applicant respectfully requests the Office to reconsider and withdraw the rejections of Claims 4, 6, 7, 13 and 16 under 35 U.S.C. § 102(b).

REJECTION UNDER 35 U.S.C. § 103

Claims 2, 5 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakagawa et al. in view of Oberlander et al. (U.S. Pat. No. 6,368,421; hereinafter "Oberlander"). Claims 8, 9, 14 and 15 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Nakagawa et al. in view of Kung (U.S. Pat. App. No. 2004/0160225; hereinafter "Kung"). These rejections are respectfully traversed.

With regard to Claims 2, 5, 8, 9, 11, 14 and 15, Applicant notes these claims depend directly or indirectly from either independent Claims 1 or 10, and thus, should be in condition for allowance for the reasons set forth for Claims 1 and 10 above.

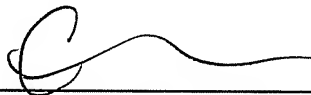
Accordingly, Applicant respectfully requests the Office to reconsider and withdraw the rejections of Claims 2, 5, 8, 9, 11, 14 and 15 under 35 U.S.C. § 103(a).

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Office reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of these remarks is respectfully requested. If the Office believes that personal communication will expedite prosecution of this application, the Office is invited to telephone the undersigned at (248) 641-1600.

Respectfully submitted,

Dated: 5/4/07

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